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09/681,393	03/28/2001	Kevin Watts	41EB-1015	3270

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EXAMINER

ALIMENTI, SUSAN C

ART UNIT	PAPER NUMBER
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3644

DATE MAILED: 08/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/681,393

**Applicant(s)**

WATTS ET AL.

**Examiner**

Susan C. Alimenti

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 26 May 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-14, 16-34 and 36-44 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14, 16-34 and 36-44 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-12, and 14-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cansler et al. (US 6,725,257) and further in view of Avery et al. (US PG Pub. 2003/0208365).

Regarding claims 1-12 and 14-16, Cansler et al. (hereinafter Cansler) discloses a method for configuring a customizable product (Cansler, col.3, lns.34-35) except the type of product is not expressly claimed. Cansler's method comprises utilizing a server and at least one user interface/computer connected via a network wherein the user may input desired product attributes, i.e. in the case of configuring a vehicle year, make, model, and/or style are input to create a base configuration and then the server matches this request with pre-stored information (Cansler, col.4, lns.31-42). The standard equipment associated with the selected base configuration is established by the server and the user is then asked to chose optional equipment and/or accessories. The final product is orderable only if all selected components are compatible (Cansler, col.3, lns.58-65). Upon discovering incompatibility between selected options, the server automatically corrects the discrepancy and notifies the user of this conflict, resolution, and then guides the user to other options available at that time (Cansler, col.9, lns.8-26 & Figure 8). If the user manages to configure a desirable product and would like to purchase said product, the user can opt to get a quote of the finished product (Cansler, col.8, lns.6-9). The need of the user

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is considered to be assessed based upon the options and accessories chosen at step 32 (Cansler, Figure 1). Even though Cansler uses the example of the configuration of a vehicle, it is clear that this method can be applied to configuring any type of product, including but not limited to an electrical distribution device as show by Avery et al. (Avery hereafter).

The configuration is accomplished through a visual interface or computer, wherein the server provides multiple web pages. Each web page has links and tabs allowing the user to navigate amongst pages and to make decisions easily (Cansler, cols.5-6).

In the case of utilizing Cansler's device for another product it is obvious that parameters, options, accessories, etc. would be different and specific to those of the specific product being sold. Avery discloses a system and method for designing, configuring and ordering electrical distribution transformers over a network interface, wherein the user can chose between various specification requirements (Avery, ¶ [0004] – [0022]). Avery teaches that online ordering systems for transformers “assure quick and knowledgeable design,” ([004]) provide over the internet Regarding the steps of claims 1, 17, 30, 36, and 41-44, wherein the user can design a transformer by specifying a load type, “indoor” or “outdoor”, etc. are obvious design options that are standard spec requirements, well known in the art. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use Cansler's system to configure an electrical device over the internet, as described by Avery, in order to extend the Cansler's convenient configuring system to other products.

Regarding the amended limitation that generally reads, “generating, by computer, a circuit diagram of the product,” such is considered to be an inherent function of online ordering systems. While Cansler does not positively state that a figure or picture of the incomplete/final

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configured vehicle is presented to the user via the interface, such is considered obvious since the user/customer must make ordering and purchasing decisions. To make such decisions about such an expensive commodity without ever seeing what the product and its systems will look like, e.g. the drive train, engine, transmission, would be foolish and very few customers would feel comfortable with this. Therefore, it is considered inherent that Cansler would provide the user with diagrams and figures of what they are ordering and/or buying prior to such. With regard to transformers specifically, Avery teaches that “[t]he method can further include the step of creating drawings on the server based of [sic] the bill of materials and a transformer description, the drawings being adapted for download to the user’s remote location and for attachment to the request for quote.” (Avery, [0007]) It would have been obvious to one having ordinary skill in the art at the time the invention was made to use Cansler’s system, as modified, to generate a circuit diagram relating to stored product information in order to provide the user with appropriate product information prior to purchase or order.

3. Claims 1-12, 14-34, and 36-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cansler and in view of Avery.

Regarding the system of claims 18-29, the computer of claims 31-34 and the apparatus of claims 37-40, Cansler’s device is considered to comprise the claimed limitations substantially as explained in the above discussion.

Further, it is noted that the aforementioned claims are not method claims, but instead apparatus claims. It is well settled case law that such limitations, which are essentially method limitations or statements of intended or desired use, do not serve to patentably distinguish the

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claimed structure over that of the references. See: In re Pearson, 181 USPQ 641; In re Yanush, 177 USPQ 705; In re Finsterwalder, 168 USPQ 530; In re Casey, 152 USPQ 235; In re Otto, 136 USPQ 458; Ex parte Masham, 2 USPQ 2nd 1647.

See MPEP 2114 which states:

A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the *structural* limitations of the claim. Ex parte Masham, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987).

While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. In re Schreiber, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997), see also: In re Swinehart, 439 F.2d 210, 212-13, 169 USPQ 226, 228-29 (CCPA 1971); In re Danly, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959).

"[A]pparatus claims cover what a device is, not what a device does." Hewlett-Packard Co. v. Bausch & Lomb Inc., 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990) (emphasis in original).

Where a system exists to configure a product online, as it does disclosed by Cansler, the intended use, i.e. applying the system to products other than a vehicle, involves only routine skill in the art and does not distinguish the invention from the prior art.

### ***Response to Arguments***

4. Applicant's arguments filed 25 May 2005 have been fully considered but they are not persuasive. The crux of applicant's arguments is that Cansler and Avery, alone or in combination, do not disclose a system and method of configuring an electrical distribution device.

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~ The examiner disagrees and contends that Cansler clearly discloses a device capable of configuring various aspects and specifications of a *product* (emphasis added)(Cansler, claims 1-22). While Cansler et al. discuss more specifically the on-line configuration and purchase of a vehicle, they note that "other embodiments are possible that incorporate more or different features and that apply to products other than vehicles." (Cansler, col.9, lns.30-32) Cansler's online system and method for designing a product may be apply to any product inclusive of an electrical device such as a transformer. Avery is cited in the present rejection to support the contention that it is well-known in the art to design, configure, and order and electrical distribution device via a network interface. It is noted that Avery's system and method for ordering electrical distribution devices is different than the present invention, however, Avery is set forth only as a teaching to Cansler's configuration system.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In conclusion, for these reasons and those listed in the above rejections, the examiner maintains the rejections of claims 1-12, 14-34, and 36-44.

***Conclusion***

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan C. Alimenti whose telephone number is 571-272-6897. The examiner can normally be reached on Monday-Friday, 9am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Teri Luu can be reached on 571-272-7045. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.



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7. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Susan C. Alimenti



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